



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 781,117	02/08/2001	Jennifer L. Hillman	PC-0034 US	1679

27904 7590 03/04/2003

INCYTE GENOMICS, INC.
3160 PORTER DRIVE
PALO ALTO, CA 94304

EXAMINER

CHERNYSHEV, OLGA N

ART UNIT	PAPER NUMBER
----------	--------------

1646

DATE MAILED: 03/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/781,117

Applicant(s)

HILLMAN, JENNIFER L.

Examiner

Olga N. Chernyshev

Art Unit

1646

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 February 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on ____ Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: ____.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) ____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: ____.

Claim(s) objected to: ____.

Claim(s) rejected: 1-6.Claim(s) withdrawn from consideration: 7-12.

8. ☐ The proposed drawing correction filed on ____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). ____.
10. ☐ Other: ____.

Continuation of 3. Applicant's reply has overcome the following rejection(s): amendment of claims 2 and 4 overcomes the rejection of claims 2 and 6 under 112, second paragraph.

Continuation of 5. does NOT place the application in condition for allowance because: Applicant presented arguments that have been fully answered before, see reasons of record in sections 5 and 6 of paper No. 12. Briefly, it appears that Applicant's asserts two independent and unrelated specific, substantial and credible utility for the claimed isolated nucleic acids encoding TRP. First is based on its 85% identity to the protein which resembles yeast mitochondrial protein, homologues of which, in turn, are associated with the Mohr-Tranebjaerg syndrome. In view of the absence of any other factual support of such assumption, one skilled in the art would not reasonably believe that the instant nucleic acids are also associated with the same syndrome. Second, the utility of the claimed nucleic acids is asserted based on the overexpression of the TRP in breast, ovarian and kidney cancer compare to the normal tissue. One skilled in the art readily recognizes obviousness of the fact that during progressive proliferation of cancerous cells numerous proteins, most of which are ubiquitous, are overexpressed. Based on the presented limited information, it is clear that TRP is also expressed in the normal tissue and appears to be expressed at the higher levels in certain cancerous cells. If to assume that the utility of the TRP lies in the filed of being a marker for breast, ovarian and kidney cancers, then the instant specification, as filed, clearly fails to provide any guidance on how to use these markers for quantitative analysis.

2